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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/776,361 | 02/10/2004 | Holger Edinger | A-3891 | 3215 |
| 24131 | 7590 | 05/25/2005 | EXAMINER | |
| LERNER AND GREENBERG, PA P O BOX 2480 HOLLYWOOD, FL 33022-2480 | | | MORRISON, THOMAS A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3653 | |

DATE MAILED: 05/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | | |
|------------------------------|------------------------|--|---------------------|--|
| Office Action Summary | Application No. | | Applicant(s) | |
| | 10/776,361 | | EDINGER, HOLGER | |
| | Examiner | | Art Unit | |
| | Thomas A. Morrison | | 3653 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 09 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding the independent claim 1 and its dependent claims 2-4, claim 1 recites the limitation "said suction belt" in line 7. There is insufficient antecedent basis for this limitation in the claim.

In particular, line 7 of claim 1 recites "said suction belt", which can be considered to mean that this limitation refers back to a single belt set forth in claim 1. However, line 4 of claim 1 specifically recites "at least one suction belt", which can be one or more belts (i.e., this limitation includes a plurality of belts). As such, it is unclear how many belts are claimed in claim 1.

Also, with regard to the dependent claims 3 and 4, it is unclear as to whether the covering plate is the same as the feed table or a separately claimed element.

Applicant asserts that the term "which comprises" is used to indicate a new element. Applicant also explains that the "a covering plate" is an additional element and is not the same element as the feed table. Moreover, Applicant explains that the claim language "covering plate defining said feed table" even further indicates that the covering plate is a separately claimed element from the feed table.

However, lines 1-2 of claim 4 recite, "which comprises a covering plate", which appears to set forth a new element. On the other hand, lines 2-3 of claim 4 then recite, "said covering plate **defining said feed table**". (emphasis added). The limitation set forth in lines 2-3 of claim 4 can mean that the covering plate can be considered to be the feed table. As such, it is unclear from the claim language of claim 1, as to whether the covering plate is the feed table or a new element.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Eitel et al. In particular, Eitel et al. discloses all of the limitations of claims 1-4.

Regarding the independent claim 1, Figs. 1-4 show an apparatus (1) for conveying sheets to a sheet processing machine, comprising:

a feed table (6);

at least one suction belt (i.e., two belts 4 and 4) disposed to be guided over the feed table (6) and to be subjected to suction air from an underside thereof;

the suction belt (belts 4 and 4) having at least two mutually spaced-apart rows of suction openings (7) formed therein; and

the feed table (6) having ventilation openings (61 and 62) formed therein in a region between the rows of suction openings (7) formed in the suction belt (belts 4 and 4). In particular, the limitation at least one belt encompasses the two belts (4 and 4) and the ventilation openings (61 and 62) are between the suction openings (7) in the two belts (4 and 4).

Regarding the dependent claim 2, Fig. 2 shows mutually parallel suction boxes (14 and 16) communicating with the rows of suction openings (7) for supplying suction air to the rows of suction openings (7), and a common vacuum source (17) communicating with the suction boxes.

Regarding the dependent claim 3, Fig. 1 shows a covering plate (including 6) covering the suction boxes (14 and 16) on top, the covering plate (including 6) defining the feed table and a guide for the suction belt (belts 4 and 4). The covering plate (including 6) guides the belts 4 and 4.

Regarding the dependent claim 4, Figs. 1 and 2 show that the covering plate (including 6) is formed with mutually parallel rows of suction openings (2) and with the ventilation openings (61 and 62).

Response to Amendment

3. Applicant's arguments filed May 9, 2005 have been fully considered but they are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s).

For example, Applicant explains the Eitel patent and then explains that, "This is contrary to the present invention as claimed in which **the ventilation openings are in contact with the lower side of the conveyer belt**". (emphasis added). See page 5 of applicant's May 9, 2005 amendment. However, claims 1-4 of the instant application do not recite that the ventilation openings are in contact with the lower side of the conveyer belt. Rather, claim 1 recites, "said feed table having ventilation openings formed therein in a region between said rows of suction openings formed in said suction belt".

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Even if the argued limitation was added to claim 1 of the instant application, the openings (2) in Fig. 2 of the Eitel patent could be considered to be ventilation openings in contact with the lower side of the suction belt.

Moreover, applicant explains that the reference does not show the suction belt having at least two mutually spaced-apart rows of suction openings formed therein, and the feed table having ventilation openings formed therein in a region between the rows of suction openings formed in the suction belt, as recited in claim 1. In particular, Applicant asserts that this limitation "requires that ventilation holes in the feed table be underneath and **in direct contact with the lower side of the suction belt**". (emphasis added). See page 6 of applicant's May 9, 2005 amendment. Again, this limitation is not included in claims 1-4 of the instant application.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In addition, applicant argues that, "Eitel does not disclose that the compensation bore holes are disposed between suction opening of one conveyer belt." See page 6 of applicant's May 9, 2005 amendment. However, this limitation is not included in claims 1-4 of the instant application. Rather, claim 1 of the instant application recites "**at least one** suction belt". (emphasis added).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The limitation "at least one suction belt" in claim 1 can mean **a plurality of suction belts**. After this belt limitation, claim 1 recites "said suction belt having at least two mutually spaced-apart rows of suction openings formed therein; and said feed table having ventilation openings formed therein in a region between said rows of suction openings formed in said suction belt." As explained in the rejection of claims 1-4 above, the Eitel patent discloses arrangements of suction openings (7) in belts (4 and 4) and ventilation openings (61 and 62) that meet the limitations as set forth in claims 1-4.


Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Morrison whose telephone number is (571) 272-7221. The examiner can normally be reached on M-F, 8am - 5pm.

Art Unit: 3653

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on (571) 272-6944. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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